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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,348	03/16/2001	Steve Tilman	40655-201257	7734

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EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/811,348	Applicant(s) TILMAN, STEVE	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 12/19/2005 has been entered. Claims 1-25, 30-33 (method), and 26-29 (system) (or 1-33) are pending and are rejected as followed.

Specification

1. The disclosure is objected to because of the following informalities:

1) On page 2, the phrase "Fig. 7 (consisting of pages 7A, 7B, and 7C) are improper. Similarly, the practice of Fig. 8 and 10, on the same page is improper. Just use the actual Figure such as 7A, or 7B or 7C instead of Fig. 7 or Fig. 8 or Fig. 10. Corrections are needed on page 4, 11, 15 and wherever appropriate for the corrections with respect to Fig. 7 or 8 or 10 above.

2) On page 4 or 11, the phrase "y-axis" or "x-axis" is vague and indefinite since the drawings have no citation of "y-axis" for "HLG" or "LRV" and "x-axis" for "spectrum order". The drawings need to be corrected to include labels of "y-axis" or "x-axis" with the appropriate unit.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-25, 30-33 (method) and 26-29 (system) are rejected under 35 U.S.C.

112, first paragraph, as failing to comply with the enablement requirement. The claim(s)

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contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fail to include at least example of how to carry out each of the steps of:

- (2) "selecting a BCF",
- (4) "targeting a 1st set of selected rows and selected columns within said BCF ...",
- (6) "targeting a 2nd set of selected rows and selected columns based at least in part on said exposure value",
- (8) targeting a 3rd set of selected rows and selected columns", and
- (10) targeting a 4th set of selected rows and selected columns based at least in part on said spatial emphasis".

And how the steps are related or working together to complete the result or a "final color" based on steps (2)-(10) above. In other word, does the claim call for a selection of 4 separate colors based on those tests above or just one final color based on the combination/optimization of the 5 tests above to yield the desired color for all of the functions cited above? A demonstration is needed to show how to integrate those 5 functions above to yield the desired color.

4. Claims 1-25, 30-33 (method) and 26-29 (system) are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A final step of integrating the 5 functions above to yield the desired/optimized color to meet the 5 functions above is critical or essential to the practice of the invention, but not included in

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the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

In system claims 26-29, it's not clear how the step of "determine a range of colors from a HLG ..." in the processor is carried out to provide a result and yield the next step of "output said range of colors". There is no discussion in the specification of how the processor is being programmed or configured to carry out this step.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-25, 30-33, 26-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the four statutory classes of invention as set forth in § 101 (i.e. (1) a process, (2) machine (apparatus), (3) manufacture (article of manufacture), or (4) composition of matter).

In the present case, Method claim 1 is directed to a "method for selecting one or more colors", which is not within one of the classes of invention set forth in § 101.

The "method for selecting one or more colors" comprising the steps cited in claim 1 or 26,

are merely a disembodied abstract idea and do not produce a (1) useful and (2) tangible, and (3) concrete result. The result of the instant invention is one or more selection of a color. The result (value) might be considered "useful" in selecting a color

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or more colors. However, § 101, 2nd test requires that the result be reproducible or repeatable to meet the tangible and concrete requirement. See *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Circuit 2000). In the instant case, it's not clear how the 2nd, 4th, 6th or 8th or the integration of these steps together to form a desired color is carried out? There is no citation in the specification of how this step is carried out and no example has been cited.

Moreover, each of step (2), (4), (6), (8) or (10) above is carried out mentally thus it's subjective, varying based on each person's value, personal preference, etc. and can be carried out any way or step, depending on each circumstance, which indicates that the value is changeable, unpredictable or irreproducible, varying from one person to the next. The claim is broad to include determining by human being which produces results which are subjective and irreproducible. This fails to meet the test that the result has to be concrete to meet the § 101 test. Moreover, there is no physical transformation of anything to another state or thing even though this is dispositive. Therefore, claims 1-25, 20-33 and 26-29 are thus drawn to the abstract idea of "selecting one or more colors", rather than to a practical application of the idea as required by 35 U.S.C. § 101.

Claim Rejections - 35 USC § 112

7. Claim 1 recites the limitation "said exposure value" in line 20. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 28 recites the limitation "said location" in line 3. There is insufficient antecedent basis for this limitation in the claim.

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9. Claim 26 is vague and indefinite because it's not clear how the "one or more selection criteria" is used in the claim since the next step has no connection to the "selection criteria".

Response to Arguments

10. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
April 15, 2006


DEAN T. NGUYEN
PRIMARY EXAMINER